

REMARKS

Claims 1-47 and 49-67 were pending at the time the present Office Action was mailed (September 5, 2007).

The applicant's attorney thanks the Examiner for his consideration during a telephone interview conducted on January 23, 2008. During the interview, we discussed the differences between applicant's claims and Ryan and Giacomozzi with respect to the person that is targeted for advertisements and the basis on which the person is targeted for advertisements. The Examiner suggested that this response focus on the ineffectiveness of the references to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Applicant has taken the Examiner's suggestion and has included the suggested arguments among others herein.

The Examiner rejected the claims under 35 U.S.C. § 103(a) as set forth in the following table. Applicant respectfully traverses these rejections below.

Claims	References
1-7, 11, 14, 16-18, 20-23, 26-27, 29-32, 34-40, 43-45, 49, 51-54, 57-59, and 61-67	Ryan (6,173,274) and Giacomozzi (WO 96/29263)
8-9, 24, 28, 42, and 56	Ryan, Giacomozzi, and Itkonen (5,473,863)
10, 25, 33, 41, 55, 60, and 64	Ryan, Giacomozzi, and Crossman (5,035,515)
12-13, 15, 19, 46-47, and 50	Ryan, Giacomozzi, and Loeb (6,421,652)

Claim 1 is directed to a computer system for processing a paper product. The computer system includes a product order tracker configured to receive a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer. The paper product includes a roll of paper or a plurality of unbound, stacked paper sheets. The computer system further includes a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product. The promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party

advertiser. The computer system also includes a paper product tracker configured to provide instructions for creating the enclosure for the paper product. The enclosure has the promotional material of the received promotional material order. The paper product tracker is also configured to provide instructions to enclose the paper product of the received order with the created enclosure. The paper manufacturer, the paper purchaser, and the third-party advertiser are different entities, and the third-party advertiser pays to have the promotional material placed on the enclosure of the paper product.

Ryan describes a production mail system for printing messages, such as advertisements, on envelopes addressed to a single, specific recipient. During operation, the sender submits a mailing list to the data processing system for processing. Ryan, col. 11:28-30. The mailing list includes multiple recipient addresses to which the sender wishes to send mail pieces. Ryan, col. 11:30-32. The data processing system reviews the mailing list and determines which recipients should have advertisements printed on their envelopes. Ryan, col. 11:41-46. The data processing system also selects advertisements for each specific recipient based on the advertiser's restriction data, the recipient's address, and the demographic information in an address demographics database. Ryan, col. 11:61-67. As a result, one or more specific advertisements are printed on each envelope, and are targeted to the single recipient of the envelope. Ryan, col. 12:28-29.

Giacomozzi discloses paper handkerchief wrappers that have advertisements printed on the outside of the wrappers. The advertisements are not linked to the handkerchiefs and Giacomozzi's method does not exercise any control over who will see each advertisement. In particular, the advertisements are not targeted to any specific person or group of people.

In direct contrast to both Ryan and Giacomozzi, applicant's technology is related to placing advertisements on enclosures for paper products with the advertisements specifically targeted to a group of people that are likely to be exposed to the paper products. Applicant's technology is distinguished from Ryan for at least the reason that

Ryan's system targets advertisements to a single individual (the recipient of the letter). Applicant's technology is distinguished from Giacomozzi for at least the reason that Giacomozzi's system does not exercise any control over who receives or sees the advertisements.

The Examiner argues that Ryan teaches targeting a group, rather than a single recipient (see Interview Summary, January 25, 2008, Continuation Sheet). The section of Ryan referred to by the Examiner discloses presorting multiple letters of outgoing mail to take advantage of a postal discount. Ryan, col. 13:32-34. It is not correct to say that a batch of Ryan's letters is the same as one of applicant's paper products (be it a roll of paper or a stack of unbound paper sheets) for at least the reason that a batch of Ryan's letters is not surrounded by an enclosure having promotional material. This section of Ryan and others clearly show that each individual piece of mail is addressed to a single recipient, and the advertisements placed on each piece of mail target only that single recipient. There is nothing in Ryan that teaches or suggests that a single letter would be viewed by a group of people, or that the sender of the letter is aware of that group so as to target advertisements to them. Another passage cited by the Examiner on this point (Ryan, col. 3:1-2) discloses the disadvantages of a non-targeted advertising arrangement, which further supports Ryan's disclosure of advertisements directed to individual recipients, but teaches away from targeting groups. In particular, applicant's technology includes placing advertisements on individual enclosures, with the advertisements directed to a group of recipients. For example, claim 1 includes "plac[ing] promotional material on an enclosure of a paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser." Of course, this step can be repeated for other individual enclosures, but there is nothing in Ryan that teaches or suggests that the advertisements on individual enclosures are each directed to a "group of people associated with the paper purchaser." Giacomozzi does not target advertisements at all, but rather assumes that anyone in the general public might view the

paper handkerchief wrappers. Thus, applicant's claims are patentable over the combination of Ryan and Giacomozzi. Accordingly, applicant respectfully requests that these rejections be withdrawn.

During the January 23, 2008 telephone interview, the Examiner suggested that this response focus on the ineffectiveness of the references to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As noted in an earlier response, and as expanded on below, even if Ryan and Giacomozzi taken together disclosed all the claimed features, these references teach away from the combination. Ryan teaches away from placing promotional material on Giacomozzi's wrappers. Specifically, Ryan teaches away from placing promotional material on items when "the third party advertiser cannot exercise any control over who receives the message." Ryan, col. 2:65-66. Thus, Ryan teaches away from placing promotional material on Giacomozzi's wrappers because the advertiser cannot exercise any control over who receives the message. Rather, the message is received by random individuals who either purchase Giacomozzi's handkerchief packages or notice the promotional message on one of Giacomozzi's handkerchief packages. This is precisely the type of advertising Ryan's invention is designed to avoid. As the Examiner correctly noted previously, Ryan's invention is directed at "resolv[ing] this problem by giving advertisers control over targeting their messages." Office Action, August 16, 2006, p. 10. Accordingly, the Examiner's suggested use of Ryan's system to print promotional material onto Giacomozzi's wrappers contravenes one purpose of Ryan's invention—overcoming the disadvantage of conventional advertising campaigns in which "the third party advertiser has no assurance that a target audience would be reached." Ryan, col. 2:67 – col. 3:1.

Giacomozzi also teaches away from combining his disclosed features with those of Ryan. Giacomozzi's system is directed to displaying promotional messages to the public at large, not messages targeted to a specific recipient (including the purchaser of the paper handkerchiefs). For example, Giacomozzi states, "[t]he wrapping containing paper handkerchiefs, in fact, is pulled out and shown, by the user, to the public each time a

handkerchief is taken from the same, and this represents a possible publicity vehicle with large diffusion." Giacomozzi, p. 1. Ryan targets promotional messages to the single recipient of a message, in direct conflict with the large diffusion for which Giacomozzi's system is designed. Therefore, one skilled in the art would not be motivated to combine Ryan's disclosed features with those of Giacomozzi, or Giacomozzi's disclosed features with those of Ryan. For at least the foregoing reasons, Ryan and Giacomozzi fail to establish a *prima facie* case for rejecting claim 1 under Section 103.

Applicant respectfully submits that "an enclosure" for a "paper product including a roll of paper or a plurality of unbound, stacked paper sheets," as included, for example, in claim 1 differs significantly from the envelopes and handkerchief wrappers of Ryan and Giacomozzi. The differences are evident, for example, with respect to: 1) the delivery means for the product, 2) what happens to the product before use, and 3) who is exposed to the product. An envelope, as in Ryan, typically arrives at a recipient's address, is read and opened by the recipient, and then is quickly discarded. A handkerchief wrapper, as in Giacomozzi, typically sits on a store shelf where it is exposed to an unknown group of people, is purchased, and then is stored in a purse or a pocket except for brief periods when a handkerchief is removed, at which time it may again be exposed to an unknown group of people. By contrast, the enclosures of the pending claims, which enclose rolls of paper or unbound, stacked paper sheets (e.g., on reams of paper), typically sit stacked in an oft-frequented office area (e.g., a copy room) for weeks or months at a time. The people exposed to the enclosures are typically an identifiable audience, e.g., the office employees. Thus, it is possible to place promotional material on such an enclosure that is targeted to a known group of people and that will be exposed to the people for an extended period of time. Neither Ryan nor Giacomozzi teach or suggest this type of advertising. Thus, for at least this additional reason, applicant's claims are not obvious over the combination of Ryan and Giacomozzi, and are patentable for at least this additional reason.

The remaining pending claims include elements generally similar to those discussed above with reference to claim 1. Independent claims 11, 22, 31, 49 and 65 include promotional material "specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser." Independent claim 18 includes an advertisement "specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser." Claims 12-17, 19, 20, 23-30, 32-47, 50, 51 and 53-64 all depend from one of the foregoing independent claims. Accordingly, for at least the foregoing reasons and for the additional features of these dependent claims, the Section 103 rejections of these claims should be withdrawn.

The claims depending from claim 1 are patentable over the combination of Ryan and Giacomozzi for at least the foregoing reasons and for the additional features of these claims. In rejecting claims 8-9, the Examiner relies on Itkonen for teaching a roll of paper. In rejecting claim 10, the Examiner relies on Crossman for teaching promotional messages that are coupons. However, Itkonen and Crossman fail to cure the deficiencies described above with reference to Ryan and Giacomozzi for at least the reason that Itkonen and Crossman fail to disclose or suggest targeting advertisements to a group of people associated with a paper purchaser. Therefore, claims 2-10 and 66-67 are patentable over the references relied on by the Examiner for the reasons discussed above and based on the additional features of these dependent claims. Accordingly, applicant respectfully requests that this rejection be withdrawn.

Based on the foregoing amendments and remarks, applicant respectfully requests reconsideration of this application and its early allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3265. Applicant believes all required fees are being paid in connection with this response.

However, if an additional fee is due, please charge our Deposit Account No. 50-0665, under Order No. 335828001US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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